



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,104	10/03/2002	Jun Akedo	KNI-162-A	9552
21828	7590	11/17/2004		
CARRIER BLACKMAN AND ASSOCIATES 24101 NOVI ROAD SUITE 100 NOVI, MI 48375			EXAMINER	BLACKWELL RUDASIL, GWENDOLYN A
			ART UNIT	PAPER NUMBER
			1775	

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/070,104	AKEDO ET AL	
	Examiner Gwendolyn A. Blackwell-Rudasill	Art Unit 1775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 August 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-28 and 44-72 is/are pending in the application.
- 4a) Of the above claim(s) 11-28,44-56 and 72 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-4,6,8-10 and 57-71 is/are rejected.
- 7) Claim(s) 5 and 7 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 19 February 2002 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/02</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-28 and 44-72 are currently pending. Claims 29-43 are cancelled. Claims 1-10 and 57-71 are elected and will be examined on the merits. Claims 11-28, 44-56, and 72 are withdrawn as being drawn to non-elected inventions.

Election/Restrictions

2. Applicant's election with traverse of Group I, claims 1-10 and 57-71 in the reply filed on August 26, 2004 is acknowledged. The traversal is on the ground(s) that examination of the entire application would not place a serious burden on the Examiner. This argument has been considered, but not found persuasive.

MPEP § 808.02 recites that for the purposes of the initial requirement of a restriction, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02. Since the Examiner has shown a separate status for the four groups of claims, a burden for examining all four groups has been shown.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 10, and 57-71 are rejected under 35 U.S.C. 102(e) as being anticipated by United States Patent no. 6,280,802, Akedo et al.

Regarding claim 1

Akedo et al disclose a film formed of ultrafine particles of materials such as PZT, titanium dioxide, and Mn-Zn ferrite, (column 11, lines 56-67), that has superior density and achieves a strong bond between the particles and the substrate with the crystal properties of the particles being able to be maintained, (column 2, lines 50-60), meeting the requirements of claim 1.

Regarding claims 2-4

The film can be formed without the need for heat, (column 12, lines 59-65), meeting the requirements of claim 2. The particle (crystallite) size ranges from 10 nm - 5 µm, (column 2, line 50), with the film having a density (compactness) of not less than 95%, (column 13, claim 1), meeting the requirements of claims 3-4.

Regarding claims 10

Material such as metal and ceramics are used for the substrate, (column 12, lines 4-10), meeting the requirements of claim 10.

Regarding claims 57-71

Claims 57-71 are product by process claim wherein the patentability of the product does not depend on its method of production. "If the product in the product by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." See MPEP 2113. Because the process of

making the Akedo et al invention results in a final product that is substantially the same as that claimed by Applicant, the process limitations within claims 57-71 do not provide patentable distinction between the claimed invention and the prior art of record, absent an evidentiary showing to the contrary.

5. Claims 1-4, 10, and 57-71 are rejected under 35 U.S.C. 102(e) as being anticipated by United States Patent no. 6,531,187, Akedo.

Regarding claim 1

Akedo discloses an ultrafine particle film wherein the particles are anchored to the substrate to form an underlying layer, (column 3, lines 47-52). PZT and titanium dioxide are examples of materials used for the particles, (column 3, lines 38-43). The deposited film has a polycrystalline structure with crystallites ranging in size from 0.1-0.5 μm , (column 5, lines 47-58), meeting the requirements of claim 1.

Regarding claims 2-4

Heat is not needed for the formation of the film, (column 1, lines 52-57), meeting the requirements of claim 2. The deposited film has crystallite structures ranging in size from 0.1-0.5 μm , (column 5, lines 47-58), with the density (compactness) of the film being 97%, (column 6, lines 16-29), meeting the requirements of claims 3-4.

Regarding claim 10

The substrate can be made of materials such as silicon or stainless steel, (column 3, lines 42-43), meeting the requirements of claim 10.

Regarding claims 57-71

Claims 57-71 are product by process claim wherein the patentability of the product does not depend on its method of production. “If the product in the product by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *See MPEP 2113.* Because the process of making the Akedo et al invention results in a final product that is substantially the same as that claimed by Applicant, the process limitations within claims 57-71 do not provide patentable distinction between the claimed invention and the prior art of record, absent an evidentiary showing to the contrary.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent no. 6,280,802, Akedo et al as applied to claim 1 above.

Akedo et al disclose the limitations of claim 1 as set forth above. In addition, Akedo et al also disclose that if the particles to be deposited are oxide materials using air, oxygen, or other oxidizing agent, the oxygen deficiency in the oxides during deposition can be controlled, (column 5, lines 1-8). Akedo et al do not specifically disclose the aspect ratio of the crystals nor that there is a nonstoichiometric deficiency.

Because Akedo et al disclose that the oxygen deficiency of the deposited film can be controlled, it would be within the skill of one in the art at the time of invention to modify the amount of oxygen in the in order to generate a film with improved characteristics and functionality, (columns 12-13, lines 59-5). It would further be within the skill of one in the art at the time of invention to modify the size of the particle and thus the aspect ratio in order to have a particle size which is not fused or decomposed thereby forming a thin film with superior density and adhesion, (column 2, lines 50-55).

Allowable Subject Matter

9. Claims 5 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record do not teach or suggest that the composite structure could have compactness of 99% or more having a crystallite size of 50 nm or less. In addition there is no

teaching or suggestion that other elements do not segregate on the boundary face of the crystals forming the structure.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gwendolyn A. Blackwell-Rudasill whose telephone number is (571) 272-1533. The examiner can normally be reached on Monday - Thursday; 5:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gwendolyn A. Blackwell-Rudasill
Examiner
Art Unit 1775


gbr


DEBORAH JONES
SUPERVISORY PATENT EXAMINER